

25 Metro Drive
Suite 700San Jose
California 95110T. 408-453-9200
F. 408-453-7979Austin, TX
Newport Beach, CA
San Francisco, CAskjerven morrill
macpherson LLP

Date: December 3, 2001
To: Examiner B.J. Forman
Examiner, Art Unit 1655
U.S.P.T.O.

Fax Telephone #: (703) 746 5012

Office Telephone #: (703) 306 5878

From: Mark Schmidt
Subject: 09/613,006
Client/File: M-9216 US

Date Sent:	Dec 3.01
Time Sent:	9:56
Fax Operator:	R. Kelly

This transmittal consists of 15 page(s), including this cover sheet.

Message:

Examiner Forman,

Attached please find a copy of a response to the final office action of September 19, 2001 in application 09/613,006. Also find a copy of an Express Mail label indicating that the response was mailed November 7, 2001 by Express Mail, and copies of a transmittal letter and of two references submitted with the response.

Please feel free to call me if you have any questions regarding these documents.

Sincerely,

Mark E. Schmidt

Mark E. Schmidt

If you do not receive all pages, please call (408) 453-9200

THE INFORMATION CONTAINED IN THIS FACSIMILE MESSAGE IS INTENDED ONLY FOR THE PERSONAL AND CONFIDENTIAL USE OF THE DESIGNATED RECIPIENT(S) NAMED ABOVE. THIS MESSAGE MAY BE AN ATTORNEY-CLIENT COMMUNICATION, AND AS SUCH IS PRIVILEGED AND CONFIDENTIAL. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT OR AN AGENT RESPONSIBLE FOR DELIVERING IT TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT YOU HAVE RECEIVED THIS DOCUMENT IN ERROR AND THAT ANY REVIEW, DISSEMINATION, DISTRIBUTION OR COPYING OF THIS MESSAGE IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE TO US BY MAIL. THANK YOU.

Received from <4084537979> at 12/3/01 1:01:16 PM [Eastern Standard Time]

25 Metro Drive
Suite 700San Jose
California 95110T: 408-453-9200
F: 408-453-7979Austin, TX
Newport Beach, CA
San Francisco, CAskjerven morrill
macpherson llp

Docket No.: M-9216 US

November 7, 2001

Box AF
Commissioner For Patents
Washington, D.C. 20231

Re: Applicant(s): Schena, Mark A.
 Assignee: TeleChem International Inc.
 Title: Microarray Method Of Genotyping Multiple Samples At Multiple Loci
 Serial No.: 09/613,006
 Examiner: Forman, B.
 Docket No.: M-9216 US

Filed: July 10, 2000
 Group Art Unit: 1653

Dear Sir:

Transmitted herewith are the following documents in the above-identified application:

- (1) Return Receipt Postcard;
- (2) This Transmittal Letter (in duplicate);
- (3) Response to Final Office Action (12 pages).

- ☒ No additional fee is required.
☐ The fee has been calculated as shown below:

CLAIMS AS AMENDED

	Claims Remaining <u>After Amendment</u>		Highest No. Previously <u>Paid For</u>		Present <u>Extra</u>	<u>Rate</u>	Additional <u>Fee</u>
Total Claims	25	Minus	25	=	0	x \$18.00	\$ 0.00
Independent Claims	2	Minus	3	=	0	x \$84.00	\$ 0.00
<input type="checkbox"/> Fee of _____ for the first filing of one or more multiple dependent claims per application							\$
<input type="checkbox"/> Fee for Request for Extension of Time							\$
<u>Total additional fee for this Amendment:</u>							\$ 0.00
<input checked="" type="checkbox"/> Conditional Petition for Extension of Time: If an extension of time is required for timely filing of the enclosed document(s) after all papers filed with this transmittal have been considered, an extension of time is hereby requested.							\$
<input type="checkbox"/> Please charge our Deposit Account No. 19-2386 in the amount of							\$ 0.00
<input checked="" type="checkbox"/> Also, charge any additional fees required and credit any overpayment to our Deposit Account No. 19-2386.							\$
Total:							\$ 0.00

EXPRESS MAIL LABEL NO:

EL 701021669 US

Respectfully submitted,

*Mark E. Schmidt*Mark E. Schmidt, Ph.D.
Agent for Applicants
Reg. No. 47,063

*Do Not file
Dec 01*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

*9/B
B. Webb
12*

Applicant(s): Schena, Mark A.
Assignee: TeleChem International Inc.
Title: Microarray Method Of Genotyping Multiple Samples At Multiple Loci
Serial No.: 09/613,006 Filing Date: July 10, 2000
Examiner: Forman, B. Group Art Unit: 1655
Docket No.: M-9216 US

San Jose, California
November 7, 2001

BOX AF
COMMISSIONER FOR PATENTS
Washington, D. C. 20231.

RESPONSE TO FINAL OFFICE ACTION

Dear Sir:

This responds to the September 19, 2001 Final Office Action. Applicant requests that the Examiner consider the following remarks. Since no claims are amended in this response, Applicant believes that consideration of the remarks requires no further search by the Examiner.

REMARKS

Claims 1 and 3-26 are pending, all of which stand rejected.

Claims 1, 8, 9, 12, 14, 17, 18, 21 and 24 are rejected under 35 U.S.C. §102(b) as anticipated by Lashkari et al. (Proc. Natl. Acad. Sci. USA, 1997, 94: 13057-13062). Applicant respectfully traverses this rejection.

Independent Claim 1 recites "hybridizing the microarray with a mixture of labeled synthetic oligonucleotides...." One of ordinary skill in the art would understand the term "synthetic oligonucleotide" to refer to an oligonucleotide prepared by chemical synthesis. Applicant can find no teaching or suggestion in Lashkari et al. of a microarray hybridized with chemically synthesized oligonucleotides.

LAW OFFICES OF
SKJERVEN MORRIL
MACPHERSON LLP
25 METRO DRIVE
SUITE 700
SAN JOSE, CA 95110
(408) 453-3200
FAX (408) 452-7779